

REMARKS

The Amendments

The claims are amended to specify the invention and correct informalities. The "use" claims are replaced by method of use claims in accordance with US practice.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

The Restriction Requirement

The non-elected "use" claims 19-21 are canceled and replaced with method of use claims 22-24. Although it would appear that the restriction would still apply, it is noted that the new method claims are also amended so that the methods require the particulars of the compound claims, i.e., they require administration of a compound of the same scope as claim 1. Thus, it is urged that should the compound claims be allowed, the method of use claims should be subject to rejoinder. Reference is made to the decisions in In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); and In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1996); and the Commissioner's notice thereon dated February 28, 1996, printed in 1184 OG 86, wherein it was stated that non-elected process claims which depend from or otherwise include the limitations of allowed product claims will be rejoined and included in the examination of the application upon allowance of the product claims. Accordingly, at such time as the compound claims are allowed herein, the process claims, currently non-elected, should be rejoined in the application.

The Rejections under 35 U.S.C. §102

The several rejections of the claims under 35 U.S.C. §102 over each of the Fahmy, Ariesan, Khlaponina, Zheng and Baker Chemical Abstracts and each of Koppe (U.S. Patent No. 4,948,812), Schmitt (U.S. Patent No. 3,551,478), and Metz (U.S. Patent Nos. 4,146,637 and 4,294,851), are respectfully traversed.

It is respectfully submitted that the above amendments define applicants' claimed compounds such that the references do not disclose any compound within the scope of the instant claims. The following comments are provided to point out the particular distinctions.

Fahmy, Ariesan, Khlaponina, and Zheng all disclose compounds which require a bridging group between the two rings having a CO group and another chain requiring a CO, SO or SO₂ group. The instant claims do not encompass compounds having such a bridging group. Note that the definition of X no longer includes the recitation that "one or two -CH₂- groups may be replaced independently of one another by -O-, -S-, -(SO)-, -(SO₂)-, -CO- or -NR⁴- in such a way that in each case two O, S or N atoms or an O and an S atom are not directly connected to one another." Thus, the instant claims do not include compounds wherein X has a -CO- group in the chain. These references provide no suggestion to modify their compounds to remove the specifically required CO, SO or SO₂ groups.

The Office Action states that Baker discloses compounds meeting applicants' "formula I and composition thereof wherein R¹, R² and R³ are hydrogen ..." The instant claims are amended to provide that "at least one of the groups R¹, R² has a meaning other than H." Thus, Baker does not disclose compounds meeting all elements of the instant claims. Baker also provides no suggestion to modify its compounds to require a non-hydrogen R¹ or R² group which would meet applicants' claims.

Koppe discloses compounds of the formula (I). These compounds require a -OH group in the alkyleneoxy chain bridging the two rings. The amended definition of X above excludes such a structure. See the recitation: "with the proviso that the group X with the meaning C₂₋₄-alkyleneoxy has no hydroxy substituents." Koppe provides no suggestion to modify its compound to remove the specifically required -OH substituent.

Schmitt discloses compounds of the formula shown in col. 1 which have a bridging group of -O-X-CO-NH- between the two rings and another chain requiring a CO group. The instant claims do not encompass compounds having such a bridging group. Note that the definition of X no longer includes the recitation that "one or two -CH₂- groups may be replaced independently of one another by -O-, -S-, -(SO)-, -(SO₂)-, -CO- or -NR⁴- in such a way that in each case two O, S or N atoms or an O and an S atom are not directly connected to one another." Thus, the instant claims do not include compounds wherein X has a -CO- group in the chain. Schmitt provides no suggestion to modify its compounds to remove the specifically required carbonyl, CO, groups.

Metz '637 discloses compounds similar to those of Schmitt which have a -Y-Z-CO-NH- chain as the linker between the two cyclic groups and a CO group in the other chain also. Metz '637, thus, does not disclose compounds meeting the recitations of the instant claims, particularly the X linking group of the instant claims. Metz '851 teaches compounds similar to Metz '637 wherein a -NH-CO-C-O- chain is required linking the two cyclic groups and the other chain has a CO group, see, e.g., the first definition of Y at col. 1, lines 20-25, and formula II, col. 1. The second definition of Y in Metz '851 requires a fused heterocyclic group (see formula III, col. 2) which is also distinct from applicants' compounds. The Metz references provide no suggestion to modify their compounds to remove the specifically required carbonyl, CO, groups.

For all of the above reasons, it is urged that none of the references disclose compounds which meet all elements of the instant claims. Thus, the claims are not anticipated by these references and the rejections under 35 U.S.C. §102 should be withdrawn.

It is submitted that the claims are in condition for allowance. However, the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

Respectfully submitted,

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